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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,968	04/15/2004	Lawrence C. Lee	ADNAS 04.002	8220
480/8	7590	07/26/2010		
KERR IP GROUP, LLC			EXAMINER	
MICHAEL A. KERR			JOLLEY, KIRSTEN	
P.O. Box 18600				
RENO, NV 89511				
			ART UNIT	PAPER NUMBER
			1715	
			NOTIFICATION DATE	DELIVERY MODE
			07/26/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/825,968

**Applicant(s)**

LEE ET AL.

**Examiner**

Kirsten C. Jolley

**Art Unit**

1715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2010 and 25 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 28-36, 38, 40 and 44-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 37, 39, 41-43, 54, 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Listing of Claims***

1. It is noted that the **status identifiers for claims 38, 40, and 44 should be “Withdrawn”** instead of “Original” since the claims have been withdrawn from consideration as being directed to non-elected species (see Applicant’s response of January 20, 2009).
2. In future responses, the Examiner notes that the text of the withdrawn claims (claims 28-36, 38, 40, and 44-53) should not be listed with strikethrough, as in the response of May 25, 2010.

### ***Response to Arguments/Amendments***

3. Applicant’s arguments filed April 1, 2010 have been fully considered. Applicant stated that the Rancien et al. reference (US 2004/0063117) is invalid prior art because the date of the reference is its publication date of April 1, 2004, and that the reference is not entitled to its international filing date because the international publication was in French, not English. Applicant is correct. However, it is noted that the non-final action of December 1, 2009 does not reject the claims under 35 USC 103(a) over the US 2004/0063117 reference. Instead, the Office action rejected the claims under 35 USC 103(a) over the reference **WO 02/057548 A1**, which has a 102(b)-type publication date, and which is already of record in the case. WO 02/057548 A1 is the earlier WIPO publication of the Rancien et al. reference, and has a publication date of July 25, 2002. Because this publication is written in French, the US reference to Rancien et al. was merely used as a working English translation of the WO ‘548 document, as stated in the

previous Office action. The claims are not rejected over US 2004/0063117 as argued by Applicant.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-27, 37, 39, 41-43, and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/057548 A1.

It is noted that US 2004/0063117, hereinafter “Rancien et al.,” previously cited, is used as a working English translation of WO 02/057548, and that the paragraph numbers cited are those of the US 2004/0063117 (Rancien et al.) English-language reference.

With respect to independent claims 1, 11, 20, WO ‘548 discloses a method for authenticating an object, particularly for authenticating paper intended for serving as the medium of works of art or other documents of value (see paragraph [0005] of Rancien et al.). WO ‘548 teaches the steps of selecting a unique nucleic acid marker having a specific length and a specific sequence; selecting a media that causes said marker to adhere to a fibrous material (see paragraph [0033] of Rancien et al.); mixing said media with said marker to generate a nucleic acid marker mixture; applying said nucleic acid marker mixture to fibers (see paragraph [0018] of Rancien et al.); generating a marked fibrous material by causing said nucleic acid marker mixture to adhere to said fibers; producing a paper material by using one or more marked fibers

(see paragraph [0043] of Rancien et al.); and authenticating the paper material by detecting said unique nucleic acid marker in said marked fibrous material, said nucleic acid detected with primers particular to said unique nucleic acid having said specific length and said specific sequence (see paragraph [0036] of Rancien et al.). It is noted that WO '548 is directed to making a paper, and lacks a teaching of forming a textile material from the marked fibers. However, WO '548 teaches use of its invention to make "paper for serving as the medium of works of art," and the Examiner takes Official notice that the medium of works of art is often on canvas. Canvas is a textile material that is similarly formed from fibers. It is the Examiner's position that one having ordinary skill in the art would have been motivated to similarly form a canvas material instead of paper with the marked fibers produced by the process of WO '548 upon seeing WO '548's teaching that it is desirable to authenticate the medium of works of art. Further, one would expect similar results because the manufacture of a textile and paper would both be formed from marked fibers, and the only difference is a subsequent knitting/weaving process in place of a mass papermaking process.

As to claims 2-3, WO '548 discloses use of polyurethane as the media (see paragraph [0033] of Rancien et al.), which is a polymer.

As to independent claim 11 and claim 12, WO '548 teaches that the marker mixture may be applied to the fibers after they are made by a dyeing process (see paragraph [0018] of Rancien et al.).

As to claims 4-5, 13-14, 21-22, it is noted that a canvas used for painting is a product manufactured from fibrous materials, and may be considered a home or consumer product.

As to claims 6-7, 15-16, 23-24, WO '548 teaches use of DNA as the nucleic acid. However, it would have been obvious to have similarly used RNA since WO '548 is generally directed to the use of nucleic acid and RNA is commonly known to be the other nucleic acid (see paragraph [0042] of Rancien et al.).

As to claims 8-10, 17-19, 25-27, WO '548 teaches that the nucleic acid marker of its invention helps to identify and authenticate an object. It would have been well within the skill of an ordinary artisan to have associated the DNA marker with a plurality of product information such as the product's origin or supply chain or manufacturing information as the purpose for the DNA marker.

As to independent claim 37, WO '548 teaches spraying (see paragraph [0079] of Rancien et al.), and application on fibers (see paragraphs [0018]-[0019] of Rancien et al.). As to claims 39 and 41, WO '548 generally discloses that the DNA marker fluid may be applied at any stage during production of a fiber or after a fiber has been made, as well as during the paper-making step. It would have similarly been obvious to have sprayed the DNA marker fluid during a knitting/weaving process step in the process of making a textile material, as discussed above, with the expectation of successful results since WO '548 generally discloses addition of the marker fluid at any point during production. As to claim 42, WO '548 is silent with respect to the use of rayon as the fiber. However it would have been obvious for one having ordinary skill in the art to have selected other fibrous materials for the production of a canvas material as a matter of design preference with the expectation of similar and successful results.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sheu et al. (US 2002/0187263), Sheu et al. (US 7,115,301), WO 03/080931 A1, WO 90/14441 A1, Lebacq (US 5,139,812), Kosak et al. (US 2005/0214532), Tooth (US 4,183,989), and Hoshino et al. (US 5,602,381) are cited to demonstrate the state of the prior art with respect to Applicant's claimed invention.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kirsten C Jolley/  
Primary Examiner, Art Unit 1715

kcj